

The opinion in support of the decision being entered today was *not* written for publication in a law journal and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* YOSHINOBU SERA

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Appeal 2007-0389  
Application 09/855,149  
Technology Center 3600

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Decided: March 23, 2007

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Before MURRIEL E. CRAWFORD, ANITA PELLMAN GROSS, and  
ROBERT E. NAPPI, *Administrative Patent Judges*.

GROSS, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Sera (Appellant) appeals under 35 U.S.C. § 134 from the Examiner's final rejection of claims 1 through 18, which are all of the claims pending in this application.



We refer to the Examiner's Answer (mailed October 27, 2006) and to Appellant's Brief (filed August 21, 2006) and Reply Brief (filed September 25, 2006) for the respective arguments.

### SUMMARY OF DECISION

As a consequence of our review, we will reverse the anticipation rejection of claims 1 through 18.

### OPINION

Appellant contends (Br. 14-19) that Garfinkle fails to disclose a headquarters terminal as recited in independent claims 1, 14, 15, 16, 17, and 18. More specifically, Appellant contends (Reply Br. 3) that Garfinkle fails to disclose that the headquarters terminal selectively determines the producing/processing terminal, as recited in each of the independent claims. We agree.

Garfinkle discloses (Garfinkle, col. 5, ll. 1-12) that digital images are stored on an image server. Garfinkle further discloses (Garfinkle, col. 6, ll. 37-46) that a photographer orders prints or photographic merchandise of the digital images through the image server. The image server and the photographer are connected via the Internet (see Garfinkle, col. 6, ll. 53-55). Garfinkle discloses (Garfinkle, col. 10, ll. 28-39) that a fulfillment center receives the order from the image server and fills the order. Thus, Garfinkle's photographer corresponds to the claimed orderer terminal, the fulfillment center corresponds to the claimed producing/processing terminal, and the image server satisfies the claimed headquarters terminal.

However, each claim further recites that the headquarters terminal selectively determines the producing/processing terminal according to the received order. Garfinkle states (Garfinkle, col. 10, ll. 23-24) that "the photographer **8** selects a fulfillment center **20** which they prefer to use to fulfill all orders placed." Thus, Garfinkle's orderer terminal (the photographer) selectively determines the producing/processing terminal (the fulfillment center), not the headquarters terminal (the image server). Therefore, as Garfinkle lacks a feature of each of the independent claims, Garfinkle fails to anticipate the claims. Accordingly, we cannot sustain the anticipation rejection of claims 1 through 18.

#### REMARKS

Each of claims 14 through 17 recites one element of the system "comprising" all of the elements of the system. For example, claim 14 recites "[a] *headquarters terminal comprising*: orderer terminals ...; producing/processing terminals ...; and *a headquarters terminal* ..." (emphasis ours). It is unclear how one element can "comprise" the whole system including that element. Thus, the Examiner should consider a rejection under 35 U.S.C. § 112, second paragraph.

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ORDER

The decision of the Examiner rejecting claims 1 through 18 under  
35 U.S.C. § 102(e) is reversed.

REVERSED

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